

REMARKS

The Office Action dated July 15, 2003, has been carefully considered. In the Office Action, the Patent Examiner rejected claims 1-19 (see pg. 1; only claims 5-19 are in the patent application). Claims 5-19 as previously presented remain in the patent application. Applicant respectfully requests reconsideration and reexamination in view of the following remarks.

First, as a preliminary matter, Applicant faxed the Patent Examiner an Interview Request Form on September 16, 2003, and asked that an interview be arranged. Due to scheduling requirements of the Patent Examiner, the Patent Examiner was not able to set up a telephonic interview with the Supervisor and Applicant prior to the shortened statutory deadline of October 15, 2003, that was set by the Patent Examiner. On October 8, 2003, Applicant confirmed with the Patent Examiner, Tamra Dicus, that no further Office Actions would be issued until Applicant's interview request was acted upon and a telephonic interview was conducted pursuant to Applicant's Interview Request Form and pursuant to this amendment. For purposes of reference, Applicant encloses a copy of the Interview Request Form and looks forward to discussing and clarifying the issues raised therein with the Patent Examiner and her Supervisor.

Turning to the rejections, the § 112 rejections are respectfully traversed. First, in paragraph 3, the Patent Examiner has asserted that claim 19 does not have proper support in the specification as filed. This is not true. Applicant respectfully points out to the Patent Examiner that claim 19 has the same language as claim 9 as originally filed. Claims are part of the specification and provide support under MPEP § 608.04. Also page 11 of the patent specification provides support. Accordingly, Applicant respectfully requests that the written description requirement with respect to claim 19 to be withdrawn because it does have proper support in the original specification as filed as demonstrated by claim 9 and page 11 of the specification.

With respect to the § 112 issues of claim 10, the phrase "intended to be closed" and the phrase "such as" do not exist in claim 10. Therefore, removal of these indefiniteness rejections is respectfully solicited based on the absence of the language from the claims as previously amended. Applicant again respectfully requests these rejections to be removed.

With respect to paragraph 8 of the Office Action, the phrase "adapted to be cut/closed" also does not appear in claim 10. Applicant notes that the phrase "adapted to be cut" and "adapted to be closed" separately appear in the claim. However, there is no reference to the phrase "cut/closed" as asserted by the Patent Examiner. Accordingly,

Applicant respectfully requests this rejection to be withdrawn. As to the usage of the words "adapted to", this language and such functional language is specifically permitted under MPEP § 2173.05(g) and the express holding of *In re Venezia*, 530F.2d 956, 189 USPQ 149 (CCPA 1971). This case law precedent expressly holds that the phrase "adapted to" is specifically permitted in apparatus claims, and therefore, Applicant respectfully requests removal of this rejection.

As a further preliminary matter, Applicant has previously made a translation of the papers of record in accordance with 37 C.F.R. § 1.55 and therefore, Applicant does not understand the basis for the Examiner's continuing comment in paragraph 10 of the Office Action. Applicant has records documenting the fact that this translation has been received by the U.S. Patent and Trademark Office. Further, the Patent Examiner has removed rejections in previous Office Actions based on Applicant's submission of the translation papers. Accordingly, it is believed that this is a clerical error in the Office Action and Applicant respectfully requests the Patent Examiner's confirmation of the same and removal of this statement.

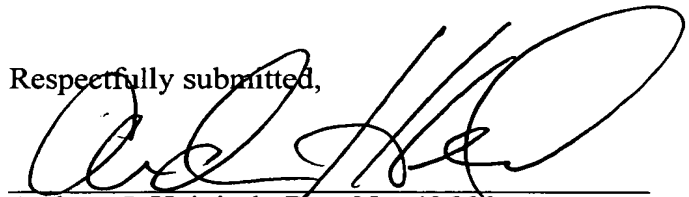
Finally, with respect to the prior art rejections, Applicant will focus on the independent claim 10 because if claim 10 is patentable, then likewise the dependent claims are patentable since the dependent claims depend and include the base limitations of independent claim 10. An anticipation rejection is only proper under MPEP § 2131 if every claim element and limitation is disclosed in a single prior art reference. See MPEP § 2131. Here, claim 10 expressly recites that the packaging is "rolled up in a longitudinal direction on a roll", and further that "mutual contact exists between the inner and outer strips in the wound state on the roll" and that these strips are "strips of cold seal coating . . . including an outer strip on the outer face of the film and an inner strip on the inner face of the film". Applicant has carefully studied Ottinger et al. and no such mutual contact between strips on opposing sides of the film exists when in the wound state on the roll. In contrast, Ottinger et al. specifically teaches the opposite as is expressly shown in FIG. 1 where the strips on opposing sides of the film (reference characters 7 and 9) never contact each other when stored in the stored state on the roll. There is no such disclosure. The limitation pertaining to mutual contact between the inner and outer strips of cold sealing coating cannot simply be ignored pursuant to MPEP § 2131 which requires every element and limitation to be expressly or inherently described in a single prior art reference.

Similarly, the anticipation rejections based upon Jones et al. cannot stand for similar reasons. Applicant notes that the Patent Examiner has made an assertion that claim 10 may alternatively be obvious, but has not suggested any motivation, teaching or suggestion in the

art to make a modification of Jones et al., and therefore, such a rejection would inherently fail under MPEP § 2143 which requires a teaching or suggestion in the art to make the asserted modification advanced by the Patent Examiner. In fact, if the Patent Examiner is making an obviousness rejection, she must state on the record that Jones et al. fails to teach certain claim limitations as recited in claim 10. This has not been done. Regardless of whether it's an anticipation or obviousness type rejection, both types of rejections still require the prior art to either disclose under MPEP § 2131 or teach or suggest under MPEP § 2143 and 2143.01 each and every element of the claimed limitation and missing one such element or limitation fails to establish such a rejection. Here, Jones et al. explicitly discloses interleaving material 3, which specifically prevents any such contact between the strips of coating on opposing sides of the subject film. This is explicitly shown in FIGS. 1 and 2 showing that no such mutual contact exists as is claimed in claim 10 and is further discussed at Col. 3, lines 10-15 which specifically states that the interleaving material "separates" the two different strips of cold seal adhesive. Thus, Jones et al. also discloses and teaches the exact opposite of what is claimed in claim 10. Accordingly, Applicant respectfully requests the prior art rejections to be removed.

In view of the foregoing, Applicant respectfully requests a Notice of Allowance to be issued and that all issues raised in the Office Action be expressly withdrawn. Pursuant to Applicant's discussion with the Patent Examiner, Applicant again reiterates its request for a telephonic interview with the Patent Examiner and her Supervisor if any rejections are going to be maintained in order to clarify the issues or Applicant's understanding for Appeal. Applicant also looks forward to the interview promised by the Patent Examiner prior to the issuance of any further Office Actions on this patent application.

Respectfully submitted,



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